

REMARKS/ARGUMENTS

Under the non-final Office Action mailed on September 8, 2004, claims 1-24 were subject to examination. Claims 1, 9, 13, 15 and 20 were rejected under 35 U.S.C. 102(b) as being anticipated by Tobish, US 5,44,775 ("Tobish"); claims 2-3, 18-19 and 23-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tobish in view of Shindo, US 5,898,774 ("Shindo"); claims 10-11, 16-17, 21-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tobish in view of Bianchini, US 4,119,089 ("Bianchini"); claims 12 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tobish in view of Shindo and in further view of Bianchini; and claims 4-8 were objected to as being dependent upon a rejected claim, but were otherwise found allowable if rewritten in independent form, including all of the limitations of their base and any intervening claims.

By way of this response, claim 4 was amended by rewriting it in independent form to include the limitations of claim 1. Because claim 4 was indicated allowable if rewritten in independent form to include the limitations of claim 1, and there were no intervening claims, it is respectfully submitted that this claim, and those dependent from it (claims 5-8), are in condition for immediate allowance.

Claims 25-27 have been added to obtain for the Applicant protection for what he regards as the full scope of the invention. These new claims include subject matter originally disclosed in this application and are within the scope of the present invention.

For the reasons to follow, it will be clear that the Action has misconstrued essential elements of the primary reference, Tobish, in asserting each of the 102(b) and 103(a) rejections. Because each of the Action's rejections rely on faulty interpretations of Tobish, the rejections should be withdrawn for this reason alone and the application given a timely notice of allowance.

Claim Rejections – 35 USC 102

The Tobish reference does not teach or suggest all of the elements of claim 1 of the present application and, therefore, does not support the 102(b) rejection of claim 1 as set forth on page 2, last paragraph, of the Office Action. To support a 102(b) rejection, the asserted reference must teach "each and every" one of the

elements of the rejected claim(s). The Action erroneously construes the Tobish reference as teaching number keys arranged to dial 1 and 9, each "bearing a tactile indicator." (See page 2, last paragraph, of the Office Action). The relevant clear and "plain meaning" of "bearing" is "to *support* the weight of" or "to *hold* above, on top, or aloft" (emphasis added). See Merriam-Webster Online Dictionary (<http://www.m-w.com>). The specification, drawings, and claims of the present application make clear that the tactile indicators are on top of *and supported* or born by their corresponding number keys. (See Figs. 1-3 and 9 of the present application.) In contrast, Tobish does not teach number keys "bearing" tactile indicators. The "locator aids" described and shown in Tobish are clearly supported entirely by the *housing* of the phone, *not* keys. The Tobish "locators" comprise an "adhesive means for affixing the [locator's] base to a *stationary* body of the telephone" to support an elaborate and cumbersome cantilevered "guide strip" that extends over but is *not* in contact with the associated number keys (emphasis provided). (See claim 1 and Figures 1 and 5 of Tobish.) The keys in Tobish clearly do not "bear", hold up, or otherwise support tactile indicators and, therefore, do not disclose, teach, or suggest the keys "bearing" tactile indicators of the present invention. Since the Tobish reference does not teach "each and every" one of claim's elements, the Action's USC 102(b) rejection of claim 1 should be withdrawn.

The Tobish reference does not teach or suggest "each and every" one of the elements of claim 9 and, therefore, does not support the 102(b) rejection of claim 9. (See page 3, paragraph 2, of the Action.) The Action asserts, without explanation or support, that the Tobish reference "reads on substantially transparent" indicators. (See page 3, paragraph 2, of the Office Action.) As explained in detail above, Tobish teaches an entirely different mechanism from the present invention, wherein Tobish does not teach tactile indicators "bearing" on keys that would inherently obstruct the face of keys but, rather, individual cantilevered strips separate from and not in contact with the keys. Tobish teaches at most that the "locators", irrespective of their appearance, have apertures formed at their ends so as not to obstruct the face of the keys. (See Figs. 4, 5, and 8 of Tobish.) Moreover, in the Action, the Examiner admits that the "'locator aids' shown in figures 1 and 5 [of Tobish] do not obscure the key, but rather mark the key's location." (See the Action, page 3, paragraph 9)

Because "transparency" is neither a suggested nor a necessary element of Tobish, the reading of this limitation into Tobish is wholly unfounded and without

support. There is clearly no suggestion in Tobish that the strips be transparent. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence **must** make clear that missing descriptive matter is **necessarily** present in the thing described in the reference,..." (emphasis added) See MPEP 2131.01 under the heading "III. TO SHOW THAT A CHARACTERISTIC NOT DISCLOSED IN THE REFERENCE IS INHERENT." Tobish, in fact, teaches away from the use of transparent material by consistently advocating the use of "an aperture which is alignable over a top surface." (See Figs. 4, 5, and 8 of Tobish.) Merely because the Examiner suggests, in hindsight, that plastic "can be see-through" does not support reading an inherent "transparency" limitation into Tobish. Because the Tobish reference clearly does not teach nor suggest a locator that is "substantially transparent" and the Action has not provided any reasons as to why the "transparency" limitation is "necessarily present" in Tobish, the rejection of claim 9 under USC 102(b) is unfounded and should therefore be withdrawn.

The Tobish reference does not teach or suggest "each and every" one of the elements of claim 15 and, therefore, does not support the 102(b) rejection of claim 15. (See page 3, paragraph 4, of the Action.) To support the rejection, the Action asserts that the Tobish reference teaches the element of claim 15 of "attaching the first auxiliary member *to the number key* arranged to dial the digit "1"..."(emphasis provided). (See the Action, page 3, paragraph 10.) As explained previously in great detail, Tobish does not teach attaching anything to the keys but of attaching cantilevered strips to the "housing" of the phone. Because the Action clearly misconstrues the teaching of Tobish as "attaching" indicators to keys, the USC 102(b) rejection of claim 15 and its dependent and intervening claims are without support and should, therefore, be withdrawn.

The Tobish reference does not teach or suggest "each and every" one of the elements of claim 20 and, therefore, does not support the 102(b) rejection of claim 20 (as set forth on page 4, last paragraph, of the Action). To support the rejection, the Action asserts that the Tobish reference teaches the element of claim 20 "of auxiliary members being adapted to be *attached to the number key*..."(emphasis provided). (See the Action, page 3, paragraph 10.) Because the action clearly misconstrues Tobish as teaching "members being adapted to be *attached to the number key*", when

it is clear that no such adaptation is taught, the rejection is wholly without foundation or support and should therefore be withdrawn.

Claim Rejections – 35 USC 103

Because the Action's reliance on Tobish as a primary reference, as applied similarly toward the USC 102(b) rejections to claims 1, 15, and 20, is unsupported in view of the above discussion, the 35 USC 103(a) rejections are likewise unsupported and should therefore be withdrawn because they inherently rely on a factually inaccurate interpretation of a principal reference. (See the Action, page 4, paragraph 2 under subheading "Claim Rejections – 35 USC 103.") Moreover, to establish a prima facie case of obviousness, the burden is on the examiner to show that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP 2143 "ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS". The elements of Tobish alone or in combination with the elements of Shindo (US 5,898,774) and/or Bianchini (US 4,119,809) do not teach or suggest all of the elements of any of the claims rejected under 35 USC 103. Consequently, since no combination of the cited references would result in the claimed invention, the rejections should be withdrawn.

In addition to misconstruing the primary Tobish reference as reading upon base claims 1, 15, and 20, the Action further misconstrues the Bianchini reference as teaching elements of the claimed invention, including a "transparent plate" which is either "overlying" (claim 10), "secured to" (claim 11), "attached to" (claims 16-17, 21, 22), or "projecting from" (claims 12 and 14) a "number key". (See page 7, starting with paragraph 7, through page 9 of the Action.) The "domed member" disclosed in Bianchini does not overlay and is not attached to a "number key" or even "number keys", but rather provides a raised overlay of tactile identifiers adjacent to "finger holes" and is attached to the rotary dial of a phone. (See Abstract, Figs 1, 4 of Bianchini.) Moreover, one of ordinary skill in the art would understand "number keys" to mean buttons with identifiers on their face, such as exist on common touch-tone phones, computer keyboards, and other electronic devices. It is not tenable, therefore, for the Examiner to construe labels adjacent to the finger holes of obsolete dial phones as number keys or a "keypad". (See page 8, 3rd and 7th paragraphs, of the Action.) The reliance on Bianchini for rejecting claims 10-11, 12, 14, 16-17, and

21-22 is, therefore, unsupported and, for these reasons and those set forth previously, the USC 103 rejections should be withdrawn.

After careful review of the record, the applicant believes new claims 25-27 are within the scope of what he considers as his invention, are patentable over the art of record, and are not "new matter".

In view of the discussion above, it is believed that none of the references of record taken either singly or in combination teach or suggest the present invention as claimed. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this application.

Respectfully submitted,

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